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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,746

12/19/2001

Yumman Chan

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01/05/2006

MIN, HSIEH & HACK LLP

USPTO CUSTOMER NO. WITH IBM/SVL

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EXAMINER

WOO, ISAAC M

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,746

Applicant(s)

CHAN ET AL.

Examiner

Isaac M. Woo

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 18, 22-25, 27, 40 and 44-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 18, 22-25, 27, 40 and 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Applicant's Amendments, filed on September 30, 2005 have been considered but are deemed moot in view of new ground of rejections below.

2. Claims 1, 23 and 45 are amended. Claims 4, 6-17, 19-21, 26, 28-39, 41-43 and 50-63 are canceled. Claims 1-3, 5, 18, 22-25, 27, 40 and 44-49 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 45-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a

certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claim 49 is not limited to tangible embodiments. Claim 49 recite "signal-bearing medium" in line 3. And in view of Applicant's disclosure, specification page 5, lines 9-21, the medium is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory and should be rejected under § 101 as not being tangible.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 23 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 23 and 45 recite, "a temporary image that indicates content that may be moved from the development environment to the production environment", which is new subject matter and not supported from specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 23 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "that" in lines 11-12. Claim 23

recites "that" in line 13. Claim 45 recites "that" in line 14. Pronouns are not permitted, only what is being referred by "that" should be set forth in the claim. May be renders the claim indefinite by failing to point out hat is being performed. Applicants are advised to amend the claim so solve the 112 rejection set forth in the claims.

Claim 1 recites, "may be" in line 12. Claim 23 recites, "may be" in line 13. Claim 45 recites, "may be" in line 14. The phrase "may be" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "may be"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 1, 23 and 45 recite, "a temporary image that indicates content that may be moved from the development environment to the production environment". The phrase "a temporary image that indicates content that may be moved from the development environment to the production environment" is not clearly understood. Claims 1, 23 and 45 recite the phrase, "wherein the development environment is separated from the production environment", which is not clearly understood. Because claimed invention is computer data management system to manipulate content data by computer program function. The *production environment and development environment* can be interpreted as computer program functions, but are not clearly understood.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5, 18, 22-25, 27, 40 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker et al (U.S. Pub. No. 2004/0049598, hereinafter, "Tucker") in view of Sawano et al (U.S. Pub. No. 2001/0006391, hereinafter, "Sawano").

With respect to claim 1, Tucker discloses, replicating (downloading from internet content server, 406, fig. 4, page 3, section [0035]) the production data (content) store from the production environment (406, internet content server) to produce a core data store (original unedited page), see (fig. 4, page 3, section [0037]) in a development environment, contents (original unedited page, page 3, section [0037] from 406, internet content server, fig. 4) are requested by internet user and stored on 240, fig. 2, internet user system), wherein the development environment is separated from the production environment (production data from 406, fig.4 to core data, unedited data, replicating); producing a shadow data (image file, page 4, sections [0037]-[0038], editor 422, fig. 4, checks the page's (core data) HTML image file and gathers images) store of a portion of the core data store (original unedited page) (fig. 4, page 4, section [0037]-[0038], image files are portion of original unedited page) within development environment; modifying the shadow data store (image file, page 4, section [0038]) to produce a modified

shadow data store, see (page 4, section [0038], image file is compressed by editor 422, fig. 4); and generating a user view (displaying), for presentation to a user, from the modified shadow data store and the core data (page 5, section [0047] displaying original unedited contents and modified, compressed, content in a user browser), to produce a temporary image a user view (cached data is temporary data and the image is presented to a user). Tucker does not explicitly disclose, "generating a user view, by combining content of the modified shadow data store with content of the core data store", which is displaying combined data to the user. However, Sawano discloses, "a third read/display program (S9) for reading the combined image data stored in the third temporarily storing portion in which the cutout image data is written and displaying the combined image data in the display device", see (page 2, section 0024) and "the processing portion reads the combined image data stored in the third temporarily storing portion to display an image obtained by combining the image based on the polygon data with the cutout image in the display device, and writes image data changed so that the individual parts based on the polygon data can be moved at predetermined cycle on the basis of the motion giving program, into the third temporarily storing portion", see (page 2-3, section 0045). This teaches that the combined image data is displayed to the user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating generating a user view, by combining content of the modified shadow data store with content of the core data store with the system of Sawano. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a combination because

that would provide combined image data to the user for user-friendly computer displaying system.

With respect to claim 2, Tucker discloses, applying the modified shadow data store to said core data store to create a modified core data store, see (page 4, section [0038]).

With respect to claim 3, Tucker discloses, propagating said modified core data store to said production data store to produce a modified production data store, see (page 4, section [0038]).

With respect to claim 5, this limitation is discussed before in claim 1 with Mukai. Thus, this is rejected as same reason above in claim 1.

With respect to claim 18, Tucker discloses, document, a software program, a software module, graphic image, a video composition, an audio composition and a web page, see (page 3, section [0037], page 4, section [0038]).

With respect to claim 22, Tucker discloses, insert operations; delete operations, and wherein update operations are combinations of insert and delete operations, see (page 3, section [0037]).

With respect to claim 23, Tucker discloses, replicating (downloading from internet content server, 406, fig. 4, page 3, section [0035]) the production data (content) store from the production environment (406, internet content server) to produce a core data store (original unedited page), see (fig. 4, page 3, section [0037]) in a development environment, contents (original unedited page, page 3, section [0037] from 406, internet content server, fig. 4) are requested by internet user and stored on 240, fig. 2, internet user system), wherein the development environment is separated from the production environment (production data from 406, fig. 4 to core data, unedited data, replicating); producing a shadow data (image file, page 4, sections [0037]-[0038], editor 422, fig. 4, checks the page's (core data) HTML image file and gathers images) store of a portion of the core data store (original unedited page) (fig. 4, page 4, section [0037]-[0038], image files are portion of original unedited page) within development environment; modifying the shadow data store (image file, page 4, section [0038]) to produce a modified shadow data store, see (page 4, section [0038], image file is compressed by editor 422, fig. 4); and generating a user view (displaying), for presentation to a user, from the modified shadow data store and the core data (page 5, section [0047] displaying original unedited contents and modified, compressed, content in a user browser), to produce a temporary image a user view (cached data is temporary data and the image is presented to a user). Tucker does not explicitly disclose, "generating a user view, by combining content of the modified shadow data store with content of the core data store", which is displaying combined data to the user. However, Sawano discloses, "a third read/display program (S9) for reading the combined image data stored in the third

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temporarily storing portion in which the cutout image data is written and displaying the combined image data in the display device”, see (page 2, section 0024) and “the processing portion reads the combined image data stored in the third temporarily storing portion to display an image obtained by combining the image based on the polygon data with the cutout image in the display device, and writes image data changed so that the individual parts based on the polygon data can be moved at predetermined cycle on the basis of the motion giving program, into the third temporarily storing portion”, see (page 2-3, section 0045). This teaches that the combined image data is displayed to the user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating generating a user view, by combining content of the modified shadow data store with content of the core data store with the system of Sawano. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a combination because that would provide combined image data to the user for user-friendly computer displaying system.

With respect to claim 24, Tucker discloses, applying the modified shadow data store to said core data store to create a modified core data store, see (page 4, section [0038]).

With respect to claim 25, Tucker discloses, propagating said modified core data store to said production data store to produce a modified production data store, see (page 4, section [0038]).

With respect to claim 27, this limitation is discussed before in claim 1 with Mukai. Thus, this is rejected as same reason above in claim 1.

With respect to claim 40, Tucker discloses, document, a software program, a software module, graphic image, a video composition, an audio composition and a web page, see (page 3, section [0037], page 4, section [0038]).

With respect to claim 44, Tucker discloses, insert operations; delete operations, and wherein update operations are combinations of insert and delete operations, see (page 3, section [0037]).

With respect to claim 45, Tucker discloses, replicating (downloading from internet content server, 406, fig. 4, page 3, section [0035]) the production data (content) store from the production environment (406, internet content server) to produce a core data store (original unedited page), see (fig. 4, page 3, section [0037]) in a development environment, contents (original unedited page, page 3, section [0037] from 406, internet content server, fig. 4) are requested by internet user and stored on 240, fig. 2, internet user system), wherein the development environment is separated from the production

environment (production data from 406, fig. 4 to core data, unedited data, replicating); producing a shadow data (image file, page 4, sections [0037]-[0038], editor 422, fig. 4, checks the page's (core data) HTML image file and gathers images) store of a portion of the core data store (original unedited page) (fig. 4, page 4, section [0037]-[0038], image files are portion of original unedited page) within development environment; modifying the shadow data store (image file, page 4, section [0038]) to produce a modified shadow data store, see (page 4, section [0038], image file is compressed by editor 422, fig. 4); and generating a user view (displaying), for presentation to a user, from the modified shadow data store and the core data (page 5, section [0047] displaying original unedited contents and modified, compressed, content in a user browser), to produce a temporary image a user view (cached data is temporary data and the image is presented to a user). Tucker does not explicitly disclose, "generating a user view, by combining content of the modified shadow data store with content of the core data store", which is displaying combined data to the user. However, Sawano discloses, "a third read/display program (S9) for reading the combined image data stored in the third temporarily storing portion in which the cutout image data is written and displaying the combined image data in the display device", see (page 2, section 0024) and "the processing portion reads the combined image data stored in the third temporarily storing portion to display an image obtained by combining the image based on the polygon data with the cutout image in the display device, and writes image data changed so that the individual parts based on the polygon data can be moved at predetermined cycle on the basis of the motion giving program, into the third temporarily storing portion", see (page

2-3, section 0045). This teaches that the combined image data is displayed to the user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating generating a user view, by combining content of the modified shadow data store with content of the core data store with the system of Sawano. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a combination because that would provide combined image data to the user for user-friendly computer displaying system.

With respect to claim 46, Tucker discloses, data storage medium capable for recording data, see (page 3, section [0041]).

With respect to claim 47, Tucker discloses, magnetic, optical, biological and atomic data storage medium, see (page 3, section [0041]).

With respect to claim 48, Tucker discloses, modulated signal medium, see (page 3, section [0041]).

With respect to claim 49, Tucker discloses, a group of networks comprising the Internet and Extranet, see (page 1, section [0002]).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

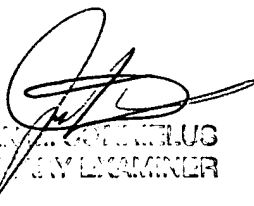
Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
December 21, 2005



ISAAC M. WOO
EXAMINER